

Appl. No. 10/696,014
Amdt. dated May 12, 2008
Reply to Office Action of March 12, 2008

PATENT

Amendments to the Drawings:

The attached sheets of drawings which include Figs. 1-7 replaces the original sheet including Figs. 1-7.

Attachment: Replacement Sheets

REMARKS/ARGUMENTS

Amendments

Before this Amendment, claims 1-22 were present for examination. Claims 1, 21, 22 are amended. No claims are cancelled. No new claims are added. Therefore, claims 1-22 are present for examination, and claims 1, 6, 11, 16, 21, and 22 are the independent claims. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended.

The Office Action has rejected claims 1-11, 16 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein et al., U.S. Patent 7,028,896 ("Goldstein"). The Office Action has rejected claims 12-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein and further in view of the cited portions of Risafi et al., U.S. Patent 6,473,500 ("Risafi").

35 U.S.C. §103(a) Rejection, Goldstein, Risafi

The Office Action has rejected claims 1-11, 16 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein. The Office Action has rejected claims 12-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein and further in view of the cited portions of Risafi.

Claims 1-11, 16 and 21-22

The Office Action has rejected claims 1-11, 16 and 21-22 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein. Notably, the Goldstein reference does not appear to teach the use of a POS device. Although a POS device was noted in the preamble of claim 1, claim 1 has now been amended to positively recite a POS in the body of the claim. Claims 6, 11 and 16 already positively recite a POS device in the body of those claims. The specification noted that a problem solved by the claimed invention is that packages of cards can be easily activated without having to scan each independent card at the POS device.

For example, if 100 cards are to be activated, customers currently have to wait for all 100 cards to be scanned individually. This creates a long wait and a sense of frustration for those customers (as well as the purchasing customer).

In contrast, Goldstein is directed at card fabrication -- not POS device sales. This can be seen from the cited portions of Goldstein. Namely, at column 1, lines 55-67, Goldstein states:

SUMMARY OF THE INVENTION

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The inventors have appreciated that in some cases it may be desirable for a card manufacturer to provide large groups of transaction cards to a customer so there are no unexpected, duplicate or missing cards. Unexpected cards are cards that have an identifier that was not supposed to be included on any card in the group or are cards that are mispositioned in the group. As used herein, a "duplicate" card is an unwanted card that has an identifier that matches one or more other cards in the group. For example, in some embodiments, a group of cards may include pairs of cards with the same identifier, such as when a pair of cards with the same identifier is issued to individuals in a family. In this

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And at column 2, lines 21-33, Goldstein states:

20 stolen in the case of missing cards from the group.

In another aspect of the invention, cards in a group may be provided in a contiguous manner such that the cards are arranged in a specific sequence. This may allow a card issuer to issue cards in a particular order and know precisely which cards have been issued and which cards are still in inventory. For example, at the time of shipment from the manufacturer, transaction cards may be arranged in numerical sequence according to an identifier encoded or printed on the cards, e.g., so card no. 1 precedes card no. 2, which precedes card no. 3, and so on. Providing the cards in a specific sequence may allow for easier inventory control of the cards, batch activation of cards, and/or ensuring that undistributed cards are still under the control of the issuer.

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Clearly, both passages are directed at a card manufacturer or card issuer providing cards to a customer in a non-POS environment. Thus, the Goldstein reference clearly does not teach card activation through the use of POS equipment

Therefore, with respect to claim 1, the Goldstein reference does not teach the claim element: **"providing a first card number corresponding to a first card in a series of cards presented at said POS device."**

With respect to claim 6, the Goldstein reference does not teach **"receiving a plurality of cards at a POS device."**

With respect to claim 11, the Goldstein reference does not teach **"communicating a validation signal so as to indicate at said POS device whether said plurality of cards can be activated."**

With respect to claim 16, the Goldstein reference does not teach **"entering a first card number into said POS device."**

Thus, for at least these reasons claims 1, 6, 11, and 16 are not made obvious by the Goldstein reference. Furthermore, the claims that depend from independent claims 1, 6, 11, and 16 are also not obvious for at least the same reason that the independent claim that they depend from are allowable.

With respect to claim 21, the Goldstein reference does not appear to teach **"configuring at least one card number for detection by a bar code scanner at a POS device when scanning said package."** Rather, the Goldstein reference is more focused on shipping cards from manufacturer to a customer and is not focused on activation at a POS device. Therefore, there is no reason for Goldstein to make at least one card number available in the package so that it can be read by a POS device.

Similarly, with respect to claim 22, the Goldstein reference does not appear to teach **"providing a package identifier on said package detectable at a POS device."**

Claims 12-15 and 17-20

The Office Action has rejected claims 12-15 and 17-20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of Goldstein and further in view of the cited portions of Risafi. Claims 12-15 depend from claim 11. The Risafi reference was cited for the additional elements of claims 12-15 but not for the elements of claim 11. Therefore, the combination of Goldstein and Risafi still fails for at least the reason that claim 11 is allowable. Furthermore, it is noted that Risafi is directed at a single card issued by a card issuer. It is not directed at activation of a plurality of cards as required by claims 12-15. Therefore, one would not be motivated to combine the teachings of Risafi and Goldstein.

Similarly, with respect to claims 17-20, those claims depend from claim 16. Thus, they are allowable for at least the same reason that claim 16 is allowable.

Prima Facie Case Issue for Claims 1-22

In order to preserve the issue, Applicant must respectfully note that the format of the Office Action is improper and therefore fails to establish a prima facie case of unpatentability. For example, with respect to claims 1, 6, 11, and 16, the Examiner has attempted to insert his own language to characterize four different independent claims. Rather than addressing each individual claim element for independent claims 1, 6, 11, and 16, the examiner has merely stated the heading:

"Activating a number of successively numbered cards"

Then, the examiner has referred to Goldstein at column 1, lines 55-67 and column 2, lines 21-33 without any further delineation of a specific claim or a specific claim element. This is improper and makes it extremely difficult for Applicant to be able to formulate a response.

As noted by MPEP §706, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide

evidence of patentability and otherwise reply completely at the earliest opportunity."

Furthermore, 37 CFR.1.104(C)(2) requires an examiner to cite to specific portions of a reference.

Namely, 37 CFR 1.104(c)(2) states:

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified."

Similarly, in the context of an appeal to the board, the Board of Patent Appeals and Interferences stated:

"As we see it, the examiner's statement of rejection includes no fewer than 40 separate rejections of the appealed claims. By setting forth such a broad-brush statement and by failing to explain with a reasonable degree of specificity any one rejection, the examiner has failed, procedurally, to establish a prima facie case of obviousness. As the court said in *Herrick*, "[a] rejection so stated defeats the intent and purpose of 35 U.S.C. 132". Accordingly, we shall reverse the examiner's rejections."

Ex parte Blanc, 13 USPQ 2d 1383, 1384-85 (B.P.A.I. 1989).

Also, in *Ex Parte Martin*, the Board of Patent Appeals and Interferences stated:

In the present instance, in both the final rejection (Paper No. 7, page 3) and the answer (Paper No. 10, page 4), the examiner, in rejecting claims 4, 10 and 12 under 35 U.S.C. § 102(b), has merely stated that the claims are rejected "as being clearly anticipated by . . . Moran" without any further elaboration in either office action of precisely **how Moran meets the specific limitations of the rejected claims**. In particular, the examiner has not addressed appellant's argument on page 8 of the brief that the structure of

Moran (1) is not a storm shelter for placement in the ground, and (2) is missing the elements of a hollow chamber because Moran includes a breaker bar extending diametrically through the bin. In addition, the examiner has not explained, and it is not clear to us, how Moran satisfies the requirement of claim 12 that the upright hollow member "ha[s] a height and diameter sufficient to permit at least one person to seek shelter therein," notwithstanding that Moran's specification is silent as to the dimensions of the bin disclosed therein. Under these circumstances, we hold that the examiner has failed to meet the examiner's initial burden of establishing a prima facie case of anticipation, such that the standing rejection of claims 4, 10 and 12 as being anticipated by Moran cannot be sustained.

Ex Parte Michael C. Martin, Appeal No. 2000-1630 (B.P.A.I. July 18, 2002)(reversing the examiner's rejection)(emphasis added)(Unpublished).

The Office Action also makes a broad brush statement at the beginning of the Office Action to indicate that it is the Applicant's responsibility to review the remaining portions of the cited references for additional possible reasons of rejection. The Federal Circuit has noted that an examiner cannot make such broad brush rejections. For example, the Federal Circuit has stated:

"The examiner cannot sit mum, leaving the applicant to shoot arrows in the dark hoping to somehow hit a secret objection harbored by the examiner. The "prima facie" case notion, the exact origin of which appears obscure . . . , seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument. To that extent the concept serves to level the playing field and reduces the likelihood of administrative arbitrariness."

See *In re Oetiker*, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992) (Plager, J., concurring).

In view of these cases, it is clear that the Office must give an Applicant more guidance as to what specific portions of a reference are being relied upon in rejecting the claims.

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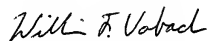
The present office action does not do so. While claims 1, 6, 11, and 16 have been used as an example, the Office Action used a similar approach for the remaining claims. Thus, the Office Action has failed to establish a prima facie case as to all pending claims.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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